

**REMARKS**

Claims 31-41, 50, 52-55, and 60-68, and 70-77 are pending in the present application. Claims 31, 39, 40-41, 50, 62, 70, and 76-77 are amended herein. Claim 69 is cancelled. No claims are added herein. All claims have been rejected, on bases further discussed below. Each ground for rejection is addressed below, and the remarks herein, considered together with the declaration of Raymond M. Broemmelsiek filed herewith, support applicant's assertion that all claims pending in this application are enabled by the specification as filed, as well as patentably distinct from the cited prior art, and are therefore in condition for allowance.

**35 U.S.C. §112, first paragraph**

All claims (31-41, 50, 52-55, and 60-68, and 70-77) have been rejected under 35 U.S.C. 112, first paragraph as failing to be properly enabled by the specification as filed. Applicant respectfully traverses this rejection.

In the Office Action it was asserted that the claims contain subject matter not described in the specification sufficiently to enable one skilled in the art to make and/or use the claimed invention. Specifically, it is asserted that the limitation "obtaining without the use of a web browser" and that the specification does not provide for a non-web browser program to render internet content.

Initially it should be noted that the language "obtaining without use of a Web browser" has been replaced in the claims of the present application by the phrase "obtaining, ... using a home application which does not present to a user general web navigation controls." (E.g.,

claim 31, lines 3-4, as amended.) It is applicant's intent by this amendment to highlight that the claimed invention does not rely on the presence of the a full-featured, dedicated web browser application, such as Microsoft Internet Explorer, Mozilla Firefox, and so forth, and indeed is designed to operate in environments in which such a web browser application is not running nor even present. However, applicant asserts that even without such a change, the application as filed supports the obtaining of Internet content without the need to rely on a dedicated, typical web browser application.

Applicant directs the examiner's attention to the following sections of the specification, as filed, which discuss aspects of obtaining internet content without the use of a web browser in sufficient detail to enable one skilled in the art to make and use the claimed invention (all references are to the paragraph-numbered substitute specification filed 12/21/2007):

- Paragraph 70
- Example 2, pages 18-20
- Paragraph 73 (e.g., lines 9-11)
- Paragraph 125-133 (all)
- Paragraph 78 (e.g., lines 4-end)
- Paragraph 112 (all)
- etc.

These are merely a sample of sections of the specification as filed which address the issue of obtaining Internet content with resort to a dedicated Web browser program, but each (and others) provide details to one of ordinary skill in the art as to how a system is programmed, and steps are performed, to produce the claimed methods.

It is not necessary that applicant provide actual code operable to produce the claimed method. Rather, all that is required is that applicant disclose sufficient details regarding the steps and apparatus performing those steps such that "a programmer of reasonable skill could write a satisfactory program with ordinary effort." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990) , cert. denied, 498 U.S 920 (1990).

Thus, in further support, applicant submits herewith the declaration of Raymond M. Broemmelsiek in which it is asserted that one of ordinary skill in the art would be able to make and use a system in which the claimed methods may be employed, as well as make and use the apparatus claimed in the present application, based on the sections of the application cited above as well as other portions of the application as filed. Decl. of Broemmelsiek, para. 8.

Accordingly, applicant asserts that the rejection of claims 31-41, 50, 52-55, and 60-68, and 70-77 under 35 U.S.C. 112, first paragraph, for failing to enable one skilled in the art has been addressed and overcome. Applicant respectfully requests removal of this rejection and reconsideration of the claims hereof.

35 U.S.C. §112, second paragraph

All claims (31-41, 50, 52-55, and 60-68, and 70-77) have been rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. There are two grounds for rejection under 35 U.S.C. 112 second paragraph. (1) Any application which renders internet content can reasonably be construed as a web browser, and therefore applicants invention cannot render web content without a web browser application, as claimed, and (2) the claims contain negative limitations

and therefore per se do not distinctly and particularly point out what applicant has invented. Applicant respectfully traverses the rejections on both of these grounds.

Rendering must be by a Web browser

Applicant has amended the claims of the present application to highlight that the invention can render internet content using a home application in which the home application “does not present to a user general web navigation controls”. That is, the home application is not a dedicated web browser application, such as Microsoft Internet Explorer, Mozilla Firefox, and so forth. Indeed, an important aspect of applicant’s invention is that it can render internet content in the absence of such a full-features, dedicated web browser application. However, it is asserted that the amendments made herein address and overcome the rejection.

But in addition, application submits herewith the Broemmelsiek declaration which states, at paragraphs 5-7 that: (1) a web browser program is understood by those skilled in the art to include general web navigation controls; (2) a program without such controls would not be considered a web browser program; and (3) the statement “any program which renders Internet content can reasonably be construed as a web browser” found in the Office Action at paragraph 7, lines 4-6, is not correct, and that in fact one skilled in the art would not conclude that a program which renders Internet content is automatically considered a web browser program. Thus, further support is provided for applicant’s assertion that, contrary to the rejection, applicant’s invention can render web content without a “web browser” application.

Negative Limitations

It was not made clear in the rejection precisely which negative limitations were objectionable, but applicant assumes that it is the phrase “without use of a web browser”.

Applicant has amended the claims of the present application to remove that phrase, and replace it with "using a home application which does not present to a user general web navigation controls" (e.g., claim 31, lines 3-4). It is respectfully asserted that this claim limitation both distinctly and particularly points out what applicant has invented. However, it should be noted that the ability to render internet content without the presence of a dedicated web browser application is an important aspect of the present invention. Thus, there remains in the claims an aspect of exclusionary claiming as to such a dedicated web browser.

It is clear from the case law that negative limitations are not impermissible per se. The Office Action cites In re Schneckter (citation in Office Action) as support for the impermissibility of the negative limitations. However, there is ample case law which makes clear that the suggestion in *Schneckter* that negative language renders a claim per se indefinite is simply not correct insofar as indefiniteness means lack of clarity as to the scope of the claim. For example in In re Bankowski, 318 F.2d 778, 138 USPQ 75 (CCPA 1963), the CCPA indicated that negative limitations do not render claims indefinite per se. See also In re Duva, 387 F.2d 402, 156 USPQ 90 (CCPA 1967).

Accordingly, applicant asserts that the rejection of claims 31-41, 50, 52-55, and 60-68, and 70-77 under 35 U.S.C. 112, second paragraph, for indefiniteness has been addressed and overcome. Applicant respectfully requests removal of the rejection under 35 U.S.C. 112, second paragraph, and reconsideration of the claims hereof.

35 U.S.C. § 103

All claims (31-41, 50, 52-55, and 60-68, and 70-77, not claims 31-77 as per the Office Action) stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Wolfe (USP 6,006,252) in view of Ko et al. (USP 6,292,185). Applicant appreciates the consideration given to applicant's prior arguments filed as to Wolfe and Ko. However, as explained below, applicant maintains its assertion that the combination of references fails to teach or suggest the invention as claimed.

Initially, and with all due respect, the Examiner's arguments in the first paragraph of part 24 of the Office Action are not clear to applicant. Applicant assumes that what is asserted is that programs 1525, 1535 "obtain" their content from within the computing system, and therefore no browser is required nor involved. That is, programs 1525, 1535 access the document from a different portion of the very machine on which they are operating, the document having been brought into that machine by some other process (presumably by a dedicated web browser application). However, even under such an argument, programs 1525 and 1535 do not "obtain" the document but rather merely the document's identity. See Wolfe, col. 8, lines 49-56, and applicant's prior response.

It is admitted that Ko teaches that data and executable files can be retrieved via the internet which, when invoked on a user's computer, change the appearance of the web browser window. However, the ultimate window presented to the user is still a window of a web browser program, merely with its appearance altered by the data and executable files.

Thus, combining Wolfe and Ko, one obtains either: (1) non-browser programs which access a document via its identity from within a computer on which they are operating files and

which alter the appearance of a web browser window and interface in which the document is displayed, or (2) web browser programs which obtain a document and which alter the appearance of the web browser window and interface in which the document is displayed. In the first case there is no "obtaining" of a document from a computer other than the computer on which the retrieving program is running, and in the second the obtaining is performed by a web browser. In either case, the combination fails to teach or suggest a program which is not a dedicated browser which obtains from a computer other than the one on which it is operating internet content and renders that internet content in a window other than the window of a web browser program.

Two amendments made amendments made herein bring added focus to the unique aspects of the present invention. First, the declaration of Broemmelsiek makes clear that a program without general web navigation controls would not be considered to be a web browser in the ordinary and reasonable sense of that term. The claims have been amended to recite that the program obtaining the internet content does not present to the user general web navigation controls. Thus, according to the claims, the obtaining of internet content is performed by a program that is not a dedicated web browser program. Second, the claims have been amended herein to make it clear that "obtaining" means that a process obtains a document from a machine other than the machine on which that process is running. Thus, in the words of the claims, the combination of Wolfe and Ko fails to teach or suggest:

a method, operating on a first computing device, for presenting Internet content to a user of said first computing device, comprising:

obtaining from a second computing device different from said first computing device, using a home application which does not present to a user general web

navigation controls, first Internet content, said content programmed in a format readable by a dedicated Web browser program; and

rendering the first Internet content in a frame having a format and controls which are specific to the first Internet content to produce a visual manifestation of the first Internet content on an output apparatus of the first computing device, the frame and first Internet content rendered using said home application, and wherein the visual manifestation of the first Internet content is not a window of a dedicated Web browser program, and further wherein the first Internet content comprises at least a portion of a definition of the frame for the visual manifestation.

(Claim 31, as amended.)

It may therefore be concluded that the combination of Wolfe and Ko fails to teach a number of limitations found in the claims, as amended. Thus, no prima facie case of obviousness exists as to the claims as they current stand. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, applicant asserts that since the cited references taken in combination fail to disclose each limitation of the claims (whether the limitation is directly recited in the claim or present by dependence on a claim containing such a limitation), those claims are patentable over that combination of references.

In addition, claims 32-41 each depend, directly or indirectly, on claim 31, claims 52-55, and 60-61 each depend, directly or indirectly, on claim 50, claims 63-68 each depend, directly or indirectly, on claim 62, claims 71-75 each depend, directly or indirectly, on claim 70, and claim



77 depends directly on claim 76. Therefore, each dependent claim contains all limitations of the respective independent claim from which it depends. As the combination of the cited references fails to teach all elements of independent claims 31, 50, 62, 70, and 76 and thus fail to render those claims prima facie obvious, for the same reasons the combination must also fail to teach all elements of dependent claims 32-41, 52-55, 60-61, 63-68, 71-75, and 77, and thus fail to render those claims prima facie obvious. Applicant therefore requests reconsideration and removal of the rejections, and allowance of all claims 31-41, 50, 52-55, and 60-68, and 70-77 currently pending in this application.

**Note Regarding Power of Attorney**

The undersigned repeats his request for the Patent Office to properly indicate the correspondence address and attorney of record for the present application. On December 21, 2007, applicant submitted a new Power of Attorney, revoking all prior Powers of Attorney and naming the undersigned as attorney in the present matter (copy previously submitted and available in PAIR). Importantly, as part of that Power of Attorney, the mailing address was to be changed to that associated with Customer Number 43785, and should read:

JAS IP Consulting  
309 2<sup>nd</sup> Street, Suite 8  
Los Altos, CA 94022

However, as of the submission date of this reply, the PAIR records for the subject case continue to reflect the prior law firm's mailing address. This resulted in yet another Office Action being sent to the wrong address, resulting in delay in the undersigned becoming aware of the Office Action. The undersigned respectfully requests that the Examiner assist with applicant's efforts to have the PTO records updated to reflect the proper attorney of record and mailing address so that no further delays in processing of this case occur.

**Conclusion**

For the foregoing reasons, the present application is in condition for allowance. Accordingly, favorable reconsideration of all claims and issuance of a formal Notice of Allowance for this application in light of the remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art. Furthermore, distinctions between the claims and cited references in addition to those made herein may exist. Thus, applicant also reserves the right to highlight some or all of those additional distinctions at a later date, if appropriate.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

/Jonathan A. Small/

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